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Attorney Docket No. 29451-8004US

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Date: September 25, 2003

By:

*Sandy Reisman*  
Sandy Reisman

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: EDWARD BALASSANIAN ET AL.

APPLICATION NO.: 09/304,973

FILED: MAY 4, 1999

FOR: **METHOD AND SYSTEM FOR  
GENERATING A MAPPING BETWEEN  
TYPES OF DATA**

EXAMINER: ANDREW T. CALDWELL

ART UNIT: 2157

CONF. NO: 1456

**RECEIVED**

SEP 30 2003

Technology Center 2100

Response to Request for Information

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The present communication responds to the Request for Information under 37 C.F.R. § 1.105. The Examiner requests applicants to:

a. Identify the allegedly infringing method that was the basis for the Petition to Make Special and any other known uses of the invention.

b. In response to this requirement, please provide a copy of each of the references referred to in the IDS filed on August 20, 2001 (paper no. 8). Although copies of items AC through AT may have been submitted to the Office, copies have not been matched to the file. Copies of these references are necessary to examine the application since they were part of the search justifying the grant of the petition to make special.

(Office Action, Sept. 2, 2003, p. 2)

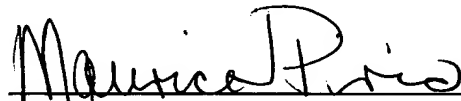
As to b., applicants are providing copies of the references previously submitted with the IDS mailed August 15, 2001.

As to a., applicants are unaware of any uses of the claimed invention at the time the application was filed. (See, 37 C.F.R. § 1.105(a)(1)(vii)). If the Examiner is requesting information on uses of the claimed invention after the filing date of the application, then applicants respectfully submit that applicants are not required under 37 C.F.R. § 1.105 to provide such information. First, such information is not "reasonably necessary to properly examine or treat the matter" as required by 37 C.F.R. § 1.105. Second, the regulations explicitly state that information on uses at the time the application was filed can be required. Clearly, if it was appropriate to include uses after the time of filing, then the limitation of this regulation would not be needed. Finally, the MPEP does not require an applicant to identify the infringing method when submitting a petition to make special based on infringement. The request of such information via § 1.105 requirement is inappropriate when a more specific rule does not require the information. Moreover, the providing of the identity of the infringing method may create a "controversy" between applicant and the infringing party that might be sufficient for the infringer to bring a declaratory judgment action once the patent issues. A § 1.105 requirement was never intended to be used to retrieve such sensitive attorney-client privileged information.

If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-8548.

Respectfully submitted,

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